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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/695,204	10/28/2003	John E. Dunn	2039.017700	4498

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EXAMINER	
CHEUNG, WILLIAM K	

ART UNIT	PAPER NUMBER
1713	

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/695,204	DUNN, JOHN E.	
	Examiner	Art Unit	
	William K Cheung	1713	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *11-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *0205*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Applicant's affirmed election with traverse of Group I invention, claims 1-10, filed October 7, 2004 is acknowledged. Applicants argue that Group I and II invention belong to the same class, it would not be an extra burden to the examiner to search for both inventions. However, applicants are reminded these inventions are distinct and recognized as divergent subject matter, it will be an extra burden to the examiner to search both inventions. Therefore, in view of the reasons set forth above, the restriction set forth by the examiner is deemed proper and is therefore made Final. However, if Group I invention is found allowable, the restriction for Group II invention will be withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-5, 7-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Birbaum et al. (US 5,760,111).

The invention of claims 1-5, 7-10 relates to a ***composition****, comprising:*
at least about ***5 wt% of a monovinylarene-conjugated diene copolymer****;*
from about ***0.1 wt% to about 2.5 wt% of an ultraviolet (UV) absorber****; and*
from about ***0.1 wt% to about 2.5 wt% of a light stabilizer.***

Birbaum et al. (col. 9, line 49-64) teach polymeric composition comprising a monovinylarene-conjugated diene copolymers as the major ingredient of a composition. Therefore, applicants' claimed "at least about 5 wt%" of claim 1, "at least about 50 wt%" of claim 3, and "at least about 95 wt%" of claim 4, are inherently possessed in Birbaum et al. Further, Birbaum et al. (col. 12, line 14-25) teach that the polymeric composition to comprise from 0.01 to 5 wt% of two or more compounds of formula (1) (col. 1, line 13-39) which is a compound comprising a phenol group and a trazin group, and one or more further stabilizers which include the HALS (col. 15, line 27-28) as claimed in applicants' claim 8. Since Birbaum et al. disclose all the limitation of claims 1-5, 7-10, claims 1-5, 7-10 are anticipated.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Birbaum et al. (US 5,760,111) in view of Ciba Literature on Tinuvin®1577 FF.

Birbaum et al. (col. 9, line 49-64) teach polymeric composition comprising a monovinylarene-conjugated diene copolymers as the major ingredient of a composition. Birbaum et al. (col. 1, line 13-39) teach a UV absorber structure comprising a phenol group and a triazin group. Regarding claim 6, Birbaum et al. (col. 1, line 13-39) clearly teach a structure that generically includes the structure as claimed.

The difference between the invention of claim 6 and Birbaum et al. is that Birbaum et al. are silent on the specific structure of claim 6.

Birbaum et al. (col. 1, line 13-39) clearly teach a structure that generically includes the structure as claimed. Therefore, motivated by the expectation of success of preparing a polymeric composition with improved photochemical and thermal stabilization (col. 1, line 1-12), it would be apparent to one of ordinary skill in art to appreciate the value of Tinuvin® 1577 FF after reading the disclosure to Birbaum. Therefore, in view of the reasons set forth, it would have been obvious to one of ordinary skill in art to use the generic structure teachings in Birbaum et al. and the literature teachings of Tinuvin® 1577 FF to obtain the invention of claim 6.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William K Cheung whose telephone number is (571) 272-1097. The examiner can normally be reached on Monday-Friday 9:00AM to 2:00PM; 4:00PM to 8:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David WU can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William K. Cheung

Primary Examiner

November 4, 2004

WILLIAM K. CHEUNG
PRIMARY EXAMINER